

**REMARKS****I. INTRODUCTION**

In response to the Office Action dated August 12, 2003, claims 23-25 and 27-30 have been cancelled, and claim 26 has been amended. Claim 26 remains in the application. Entry of these amendments, and reconsideration of the application, as amended, is requested.

**II. CLAIM AMENDMENTS**

Applicants' attorney has made amendments to the claims as indicated above. Specifically, claim 26 has been amended to recite the specific plasmids recited in cancelled claims 27 and 30. These amendments were made solely for the purpose of clarifying the language of the claims, and do not introduce new matter. Entry of these amendments is respectfully requested.

**III. INTERVIEW SUMMARY****IV. PRIORITY**

At page 2 of the Office Action, it was noted that the Applicants have not filed a certified English translation of the Korean priority application "as required by 35 U.S.C. 119(b)". Applicants respectfully note that 35 U.S.C. §119(b) requires (1) a certified copy of the priority application and (2) an English translation, both of which were provided when the application was filed with the U.S. Patent & Trademark Office on December 6, 2000. 35 U.S.C. §119(b) does not require a certified English translation of the priority application.

Applicants' undersigned representative sought clarification of this request during a telephone conversation with the Examiner on October 8, 2003, at which time the Examiner suggested Applicants submit a verified statement signed by the person who prepared the English translation, certifying that the English translation filed on December 6, 2000 is an accurate translation of the Korean priority application. Accordingly, Applicants submit herewith a verified statement signed by \_\_\_\_\_, which statement confirms that the English translation filed on December 6, 2000 is an accurate translation of the Korean priority application.

**V. REJECTION UNDER 35 U.S.C. §112, FIRST PARAGRAPH**

At pages 2-4 of the Office Action, claims 26-30 were rejected under 35 U.S.C. §112, first paragraph, because the specification enables a vaccine comprising pTV-SIV/GE+pTV-SIV/pol that prevents SIV infection in rhesus monkeys, but does not reasonably provide enablement for all other vaccines. The claims have been amended to recite the vaccine characterized as enabled by the Examiner, namely a vaccine comprising pTV-SIV/GE and pTV-SIV/pol. Accordingly, the rejection under 35 U.S.C. §112, first paragraph, is not moot and withdrawal of this rejection is respectfully requested.

**VI. PRIOR ART REJECTIONS**

At page 4 of the Office Action, claim 23 was rejected under 35 U.S.C. §103(a) as being unpatentable over Smith et al., "Viral Immunol 13:343-51, 2000, ref of record," (Smith) in view of Daniel et al., "Science 258:1938-1941, 1992, ref of record," (Daniel). At page 5 of the Office Action, claim 24 was rejected under 35 U.S.C. §103(a) as being unpatentable over Gottlinger et al., U.S. Patent No. 6,479,281 (Gottlinger) in view of Morris-Vasios et al., "J. Virol. 62:349-353, 1988," (Morris). At page 6 of the Office Action, claim 25 was rejected under 35 U.S.C. §103(a) as being unpatentable over Gottlinger in view of Morris as applied to claim 24, and further in view of Hazama et al., "Vaccine 11:629-36, 1993," (Hazama).

The cancellation of claims 23-25 renders these rejections moot.

**VII. CONCLUSION**

In view of the above, it is submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that can be resolved in a telephone interview, the Examiner is urged to call Applicants' undersigned attorney.

Respectfully submitted,

GATES & COOPER LLP  
Attorneys for Applicant(s)

**DRAFT**

Howard Hughes Center  
6701 Center Drive West, Suite 1050  
Los Angeles, CA 90045  
(310) 642-4148 (TEL) (Direct)  
(310) 641-8798 (FAX)

**Gates & Cooper LLP**

***Fax***

***For delivery directly to Examiner Kaushal – For Discussion Purposes Only***

To: Examiner Sumesh Kaushal From: Karen S. Canady

Fax: 703-746-3124 Pages: 7

Phone: 703-305-6838 Date: October 9, 2003

Re: **PROPOSED Amendment** USSN: 09/730,716

This transmission contains information that is confidential and/or legally privileged. It is intended for use only by the person to whom it is directed. If you have received this facsimile in error, please notify us by phone immediately so that we can arrange for the return of the original documents to us.

If you do NOT receive all of the pages, please phone or fax us at the above numbers.

● **Comments:**

Examiner Kaushal,

Attached are a proposed Amendment and a draft Verified Statement regarding the English translation. We believe these documents, if submitted formally, would address all remaining issues and place the application in condition for allowance. We would appreciate your review of these prior to formal submission to confirm their sufficiency or to let us know of any deficiencies that remain.

I will call you Friday, October 10, 2003, at 1:00 p.m. your time. Thank you for your kind attention to this matter.

Regards,



Karen Canady